

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the telephone discussion of October 9, 2008, during which the Examiner agreed to reconsider the restriction discussed below. The application has been carefully reviewed in light of the restriction, and applicant's representative has the following comments:

If required, applicants will elect Group IA, but with traverse and with a request for reconsideration for the following reasons: The restriction is improper for not meeting the requirements of the Unity of Invention standard. The Examiner argues in paragraph 2 of the restriction that the "method of group I does not need to have the *conveying means* transport items to the measuring means as is required by the apparatus [claim 56] of group II" (emphasis added). However, claim 35 has the step of "transporting the items from the measuring means to a cutting means on the *conveying means*" (emphasis added), and thus the method claim clearly has the cited feature. Similarly, the Examiner argues that "the apparatus of group II does not need to have work pieces *abutting* as is required by the method [claim 35] of group I" (emphasis added), but claim 56 clearly specifies the feature that "said items are placed consecutively and essentially *abutting* each other on said conveying means", and thus both claims recite the "abutting" feature. Accordingly, the stated reasons for the restriction requirement are not valid.

Furthermore, the Examiner argues in paragraphs 3-6 of the action that the claims are directed to more than one species pertaining to how the differences are calculated (the species A and B of paragraph 4). Applicant notes that the Examiner is relying on the dependent claims (e.g., claims 39, 47, 60, and 68 for species A, versus claims 40, 48, 61, and 69 for species B, all of which are dependent) for such a differentiation, which is not proper for a unity of invention standard. PCT Rule 13.4, Dependent Claims, recites:

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

Note that rule 13.1 is the unity of invention rule, which, as discussed above, is already satisfied. Accordingly, restricting the claims based on species found in *dependent* claims is clearly not proper by PCT Rule 13.4.

Furthermore, an election between species should only be required when there is a "serious burden" on the Examiner. See MPEP §818.01(a). The Examiner has not shown that the claims would be classified in separate classes, or otherwise how examining these claims is a "serious burden" on the Examiner. Applicant maintains that the election requirement is a serious burden on applicant, possibly requiring the filing of an additional application to pursue the non-elected claims. Accordingly, the Examiner should withdraw his restriction between the species. If the Examiner intends to maintain this restriction between species, the Examiner is requested to explain, on the record, why examining such claims in tandem would be considered a "serious burden."

Finally, the Examiner has failed to address what group, if any, a majority of the dependent claims would fall into (claims 36-38, 41-46, 49-55, 57-60, 62-67, and 70-72 are not addressed by the Examiner).

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. SCAN1-41081.

Respectfully submitted,
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